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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/724,841	11/28/2000	Kenneth H. Grabstein	2811-H	6624

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EXAMINER

MERTZ, PREMA MARIA

ART UNIT	PAPER NUMBER
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1646

DATE MAILED: 12/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No. 09/724,841	Applicant(s) GRABSTEIN ET AL.	
	Examiner Prema M Mertz	Art Unit 1646	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 12 December 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☒ Applicant's reply has overcome the following rejection(s): the 35 USC 112, second paragraph rejections over claims 20-30.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see continuation sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 20-30.

Claim(s) objected to: _____.

Claim(s) rejected: 36-40.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Prema Mertz
Prema M Mertz
Primary Examiner
Art Unit: 1646

Continuation of 2. NOTE: In claim 36, the new limitation "moderate stringency" is vague and indefinite because the metes and bounds of this term are unclear. Furthermore, the new limitations in claim 36 precipitate a 35 USC 112, first paragraph written description rejection because the specification only describes the nucleotide sequences set forth in SEQ ID NO:1 and 4 that encode polypeptides comprising the amino acid sequence set forth in SEQ ID NO:3 or 6, respectively. Furthermore, this limitation also precipitates a 35 USC 112, first paragraph, enablement rejection for how to make and use the invention because the specification is not enabled for a nucleic acid encoding a polypeptide having an amino acid sequence anything less than what is disclosed in SEQ ID NO:3, 6.

Furthermore, Applicants have not described the genus of nucleic acid molecules encompassing an oligonucleotide of at least 14 nucleotides. Applicants are describing the nucleic acid which the oligonucleotide hybridizes to but not the oligonucleotide itself. The claim encompasses molecules that can hybridize under "moderate stringency" and encoding polypeptides comprising SEQ ID NO:3 or SEQ ID NO:6 but the nucleic acid claimed (encompassing variants) may have different properties from those described in the specification since it is well known in the art that even a single amino acid change can alter the functional properties of a protein molecule.